

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I, Claim(s) 1-8, and 21-31, drawn to the product, precipitated silica.

Group II, Claim(s) 9-17, and 20, drawn to the process of making the claimed precipitated silica.

Applicants provisionally elect with traverse the invention of Group I, Claims 1-8 and 21-31 drawn to the product, precipitated silica.

The claims of Group I are integrally linked with the claims of Group II as product and method of making said product.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. Restriction between a product and the process for making said product is proper if it can be shown that the product can be made by another method. The instantly claimed process is narrower in scope than U.S. Pat. 6,180,076 relied upon by the Examiner, and fails to teach the ratio of Sears value V_2 BET surface area. Thus the product produced by the claimed process is sufficiently different from the prior art. Applicants respectfully traverse the restriction requirement on the ground that the Examiner has not provided sufficient reasons or examples to support patentable distinctness. Product and method of making are interdependent and should be examined together especially wherein the sole disclosed utility of the product is that recited in the specification.

Compound and process making are considered related inventions under 37 C.F.R. § 1.475(b) and unity of invention between the groups exists. Applicants submit that while PCT Rule 13.1 and 13.2 are applicable 37 C.F.R. § 1.475(e) provides in relevant part that “a

national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to products, manufacture of said products and the use of said products.” The determination of whether a group of inventions is so linked as to form a single general inventive concept should be made without regard to whether the inventions are claimed as separate claims or as an alternative within a single claim. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct and independent inventions.”

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. All of the claims are directed to precipitated silica and the process for making it.

For the reasons set forth above, Applicants request that the Restriction Requirement be withdrawn.

Applicants further request that if the invention of Group I is found allowable,
withdrawn Group II which includes all the limitation of the allowable claims be rejoined.


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